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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/761,027	01/20/2004	Heike Lerg	100718-392/ Beiersdorf 48	1877

27384 7590 04/29/2005

NORRIS, MCLAUGHLIN & MARCUS, PA  
875 THIRD STREET  
18TH FLOOR  
NEW YORK, NY 10022

EXAMINER
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HARDEE, JOHN R

ART UNIT	PAPER NUMBER
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1751

DATE MAILED: 04/29/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

16

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/761,027	LERG ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	John R. Hardee	1751	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-15 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                        | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. ____   |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date ____  | 6) <input type="checkbox"/> Other: ____                                     |

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### **DETAILED ACTION**

1. The Office appears to have misplaced the preliminary amendment adding claims 10-15. The examiner apologizes for any confusion this may have caused.

#### ***Double Patenting***

2. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

3. Claims 1-15 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-11 of U.S. Patent No. 6,706,673. Although the conflicting claims are not identical, they are not patentably distinct from each other because the patent claims a method of cleaning using a composition which has the same percentage amounts of the same composition presently claimed. Accordingly, it would have been obvious at the time the invention was made to make the claimed composition in order to use it as in the patented claims.

#### ***Claim Rejections - 35 USC § 103***

4. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

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5. Claims 1-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Klueppel et al., US 5,145,665. The reference discloses preparations for dental and oral hygiene. These compositions contain alkyl glycosides (abstract). Said glycosides may have a degree of oligomerization of 1. The alkyl group is derived from a primary alcohol of 8-22 carbons (col. 2, lines 11-32). The glycoside is present at 0.1-5% by weight (col. 2, lines 52-54). Humectants may be added to the compositions, including water-soluble Carbopols. Examiner takes the position that this teaching embraces crosslinked materials. No specific concentration of polymer is disclosed, but 0.40-1.5% of polymer is exemplified in the formulation examples. Exemplification of a gel tooth cream makes obvious the formulation of gels. Addition of polishing substances (solids) and liquids such as flavorings and water is disclosed at col. 3, lines 9-19 and is exemplified. Addition of 5-15% of glycerol is disclosed at col. 3, lines 48-49. This reference differs from the claimed subject matter in that it does not disclose a composition which reads on applicant's claims with sufficient specificity to constitute anticipation.

It would have been obvious at the time the invention was made to make such a composition, because patentees teach that all of the components claimed by applicant are suitable for inclusion in a tooth-cleaning composition. Regarding the recitation of copolymers, examiner maintains the position that the teaching in the reference of "carboxyvinyl polymers" may be fairly construed to embrace carboxyvinyl copolymers in view of the teaching of the utility of the Carbopol polymers as a class, which includes copolymers. Applicant discloses at p. 7, lines 23-25 of the specification that the Carbopols include acrylate-alkyl acrylate copolymers.

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6. Claims 1-7 and 10-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Giret et al., US 5,409,640. The reference discloses personal cleansing products. Said compositions preferably contain a polymeric skin or hair conditioning agent. Among the anionic polymers taught as useful are the Carbopols (col. 8, lines 12-20). Amounts of anionic polymer are not disclosed, but examiner takes the position that amounts at the low end of applicant's recited range are customary in the art, and therefore obvious. Compositions further comprise 0.1-20% of a nonionic or betaine surfactant. Among the nonionics disclosed as suitable are alkyl polysaccharides bearing an alkyl group of 8-18 carbons. Alkyl monosaccharide is preferably present as well at 20-70% of the total saccharide content (col. 6, lines 42-46). Inclusion of about 3% to about 40% of moisturizers, including glycerol and propylene glycol, is disclosed at col. 8, lines 43-44. Glycerol is highly preferred. This reference differs from the claimed subject matter in that it does not disclose a composition which reads on applicant's claims with sufficient specificity to constitute anticipation. It would have been obvious at the time the invention was made to make such a composition, because the reference teaches that all of the components claimed by applicant are suitable for inclusion in a personal care composition.

### ***Response to Arguments***

7. Applicant's arguments filed February 17, 2005 have been fully considered but they are not persuasive. Applicant argues that ingredients b) and c) are optional in the cited references, and that there is no motivation to add either or both. This is not persuasive because the reference teaches that they can be added. Regarding using

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each of two disclosed humectants, It is prima facie obvious to combine two compositions, each taught for the same purpose, to yield a third composition for that very purpose. *In re Kerkhoven*, 205 USPQ 1069, *In re Pinten*, 173 USPQ 801, and *In re Susi* 169 USPQ 423. When ingredients are well known and combined for their known properties, the combination is obvious absent unexpected results. *In re Crocket*, 126 USPQ 186 and *In re Pinten*, 173 USPQ 801. The person of ordinary skill in the surfactant art would expect combinations of these materials to behave in the same fashion as the individual materials, absent unexpected results.

Applicant cites *Baird*, arguing that there is no motivation to use the particular ingredients. *Baird* is not on point in the present case, as it presented a formula which was generic to tens of thousands of species. Here, there is no generic formula, and the number of possibilities is not particularly vast.

Glycerol *is* glycerin.

8. This action is NOT FINAL.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to the examiner, Dr. John R. Hardee, whose telephone number is (571) 272-1318. The examiner can normally be reached on Monday through Friday from 8:00 until 4:30. In the event that the examiner is not available, his supervisor, Dr. Yogendra Gupta, may be reached at (571) 272-1316.

The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature in black ink, appearing to read 'J. Hardee', with a long, sweeping horizontal line extending to the right.

John R. Hardee  
Primary Examiner  
April 26, 2005